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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/659,645	09/12/2000	Robert Hugh Smithson	NA11P155/99.079.01	6976

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EXAMINER

NOBAHAR, ABDULHAKIM

ART UNIT	PAPER NUMBER
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2132

DATE MAILED: 07/15/2004

8

Please find below and/or attached an Office communication concerning this application or proceeding.

[Handwritten signature]

Office Action Summary

Application No.

09/659,645

Applicant(s)

SMITHSON ET AL.

Examiner

Abdulhakim Nobahar

Art Unit

2132

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 April 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-12, 14-17, 19-29, 31-34, 36-46 and 48-51 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 31-34 is/are allowed.
- 6) ☒ Claim(s) 2-12, 14-17, 21, 22, 36-46 and 48-51 is/are rejected.
- 7) ☒ Claim(s) 19, 20 and 23-29 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Response to Arguments

This communication is in response to applicant's amendment received on April 22, 2004.

The cancellation of claims 1, 13, 18, 30, 35 and 47 are acknowledged.

The amendments to claims 2-12, 14-17, 19-29, 31-34, 36-46 and 48-51 are acknowledged and that these amendments do not introduce any new matter to the claimed invention.

Applicant's arguments have been fully considered but they are not persuasive.

Drawings

The proposed new drawings were received on April 22, 2004. These drawings are Figures 1-23.

The Figures 5, 6, 8, 10, 12, 13, 15, 17 and 20-23 are objected to because they are illegible. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 2-12, 14-17, 36-46 and 48-51 are rejected because the claimed invention is directed to non-statutory subject matter.

Claims 2-12, 14-17, 36-46 and 48-51 merely recite predefined actions to be followed upon detection of a computer virus on a computer apparatus. These claims do not claim a computer program product recorded on a computer-readable medium that would cause a computer to perform some specified inventive steps or to create any functional material such as computing process performed by the computer. Therefore, the claimed invention in these claims is characterized as functional descriptive material, per se, which does not impart functionality to a computer. See MPEP 2106 IV B1 (a). See *In re Warmerdam*, 33 F.3d 1354, 1360, 31 USPQ2d 1754, 1759 (Fed. Cir. 1994).

Claim Rejections - 35 USC § 102

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 21 and 22 are rejected under 35 U.S.C. 102(b) as being anticipated by Arnold et al. (5,440,723; hereinafter Arnold).

Regarding claims 21 and 22, Arnold discloses a method for automatically detecting and eliminating an undesirable software entity such as a virus in a computer system or in a network of computer system (see, for example, col. 2, lines 27-42). Arnold also discloses that the method includes sequence of steps (corresponding to the recited plurality of predefined actions) to be taken for preventing the spread of virus in a computer or a computer network (see, for example, col. 2, Summary of the Invention, col. 4, lines 29-59 and Fig. 2).

Allowable Subject Matter

Claims 19, 20 and 23-29 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claims 31-34 are allowed.

The following is a statement of reasons for the indication of allowable subject matter:

The primary reasons for the allowance of the independent claims 31, 32 and 34 are the inclusion of the following limitations that are not found in the prior art and they are uniquely distinct features. The closest prior art are Arnold et al. (5,440,723; hereinafter Arnold) and Kim et al. (6,701,440 B1; hereinafter Kim). Arnold discloses a method for automatically detecting and eliminating an undesirable software entity such as a virus in a computer system or in a network of computer system. Kim discloses a method for protecting a computer network by detecting e-mail viruses before the e-mail message is sent to its destination in the network. However, these two arts, singularly or in combination, fail to anticipate or render the following limitations:

"Claim 31: wherein said predefined action of blocking e-mail attachments blocks identical attachments appearing in excess of a threshold level."

"Claim 32: wherein one of said predefined actions is rendering non-accessible e-mail distribution lists and e-mail address books of e-mail clients coupled to said computer apparatus."

"Claim 33: wherein one of said predefined actions is restarting in administrator mode an e-mail post office coupled to said computer apparatus."

"Claim 34: wherein one of said predefined actions is closing down an e-mail post office coupled to said computer apparatus."

Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Abdulhakim Nobahar whose telephone number is 703-305-8074. The examiner can normally be reached on M-F 8-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gilberto Barron can be reached on 703-305-1830. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Abdulhakim Nobahar
Examiner
Art Unit 2132



AN
July 08, 2004


JUSTIN T. DARROW
PRIMARY EXAMINER